

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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EWB  
Paper No. 10

12/12/01

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Institute for Transformation, LLC  
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Serial No. 75/789,092  
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Faye L. Tomlinson of Christensen O'Connor Johnson  
Kindness PLLC for Institute for Transformation, LLC.

Andrea D. Saunders, Trademark Examining Attorney, Law  
Office 108 (David Shallant, Managing Attorney).  
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Before Simms, Hanak and Chapman, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge.

Institute for Transformation, LLC (applicant) seeks  
to register in typed drawing form SELF-AWARENESS SURVEY  
for the goods and services listed below. The intent-to-  
use application was filed on August 30, 1999.

computer software for behavioral assessment and  
prerecorded CD-ROM disks and prerecorded video  
tapes in the field of behavioral assessment  
(in International Class 9);

tutorials, namely workbooks and books in the field  
of behavioral assessment (in International Class  
16);

and

Ser. No. 75/789,092

educational services, namely, providing seminars, workshops, conferences, and instructional meetings related to behavioral assessment; in-training consultation services in the field of behavioral assessment; computer on-line global service, namely, providing a web site featuring instruction in the field of behavioral assessment (in International Class 41).

The Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicant's goods and services, is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information about a significant quality or characteristic of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). In order to be held merely descriptive, a term need not immediately convey information about all of the significant qualities or characteristics of the

relevant goods or services. A term is merely descriptive if it immediately conveys information about "one of the qualities" of the

2

Ser. No. 75/789,092

relevant goods or services. Gyulay, 3 USPQ2d at 1010.

As is readily apparent, applicant's description of its goods and services is quite lengthy. However, applicant seeks to register SELF-AWARENESS SURVEY for essentially the following goods: computer software, prerecorded video tapes, workbooks and books for behavioral assessment or in the field of behavioral assessment. Likewise, applicant seeks to register SELF-AWARENESS SURVEY for essentially the following services: educational services, in-training consultation services and computer on-line services in the field of behavioral assessment.

The Examining Attorney attached to the first Office Action a page from what applicant concedes is its web site. In its web site, applicant describes its SELF-AWARENESS SURVEY as "a survey that gives you insight into your behavior and increases your self-awareness."

Continuing, applicant states in its web site that its

SELF-AWARENESS SURVEY "is a behavioral assessment instrument, designed to describe how you view yourself at any given point in time."

At page 6 of its response to the first Office Action, applicant makes the following statement:

"Although the phrase 'self-awareness survey' does give an individual

3

Ser. No. 75/789,092

insight into his or her behavior and increases that individual's self awareness, as stated in applicant's web site, the phrase does not describe the nature, scope or extent of applicant's goods and services." If applicant is

arguing that the term "self-awareness survey" does not describe the entire nature, scope or extent of applicant's goods and services, we do not disagree.

Stated somewhat differently, we do not find that the phrase "self-awareness survey" immediately conveys information about all of the significant qualities and characteristics of applicant's goods and services.

However, as previously noted, a term is merely descriptive pursuant to Section 2(e)(1) of the Trademark

Act if it immediately conveys information about one significant quality or characteristic of applicant's goods or services.

When used in conjunction with computer software, prerecorded video tapes, workbooks and books all in the field of behavioral assessment, applicant's "mark" SELF-AWARENESS SURVEY immediately informs consumers about a significant quality or characteristic of applicant's computer software and the like, namely, that said computer software and the like contains a self-awareness survey

Ser. No. 75/789,092

(i.e. a behavioral assessment instrument). In other words, a consumer considering the purchase of one of applicant's books in the field of behavioral assessment, upon seeing applicant's "mark" SELF-AWARENESS SURVEY, would immediately understand that one key characteristic of the book is that it contains at least one self-awareness survey or, to use applicant's words, "a behavioral assessment instrument."

Likewise, with regard to applicant's services in the

field of behavioral assessment, we also find that applicant's "mark" SELF-AWARENESS SURVEY immediately conveys to consumers information about an important quality or characteristic of applicant's services, namely, that they provide a self-awareness survey.

At page 3 of its brief, applicant argues that "the phrase 'self-awareness' is not synonymous with behavioral assessment. One might be provided objective data about behavioral aspects of one's personality and never become 'self-aware.'"

Assuming for the pure sake of argument that the phrase "self-awareness" is not merely descriptive of applicant's goods and services, the fact remains that applicant is not seeking to register SELF-AWARENESS, but rather is seeking to

register SELF-AWARENESS SURVEY. We have no doubt that the entire "mark" SELF-AWARENESS SURVEY immediately conveys information about a significant quality or characteristic of applicant's goods and services in the field of behavioral assessment, namely, that they offer a self-awareness

survey.

Decision: The refusal to register is affirmed.

